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In re Application of
HIRANO, Satoshi, et al.
Application No.: 09/889,090
PCT No.: PCT/EP00/11250
Int. Filing Date: 10 November 2000
Priority Date: 12 November 1999
Attorney's Docket No.: PHJ 99.024
For: LIQUID CRYSTAL DISPLAY
APPARATUS

DECISION ON

PAPERS

UNDER 37 CFR 1.42

This is a decision on the national stage application papers submitted 11 July 2001 for entry into the national stage in the United States of America. A review of the Declaration reveals an indication that the joint inventor Takeo Kamiya is deceased. Applicants' submission of the application papers taken together with the indication that joint inventor Kamiya is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 10 November 2000, applicants filed international application PCT/EP00/11250, which claimed a priority date of 12 November 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 25 May 2001.

On 11 July 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration signed by the joint inventors, which included an indication that joint inventor Takeo Kamiya is deceased.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42. As "the terms 'Executor' and 'Administrator' do not have exact counterparts in all foreign countries, ... the terms must be construed to fit the circumstances of the case." MPEP 409.01(d). Thus, "the person or persons having authority corresponding to that of

executor or administrator are permitted to make application..." MPEP 409.01(d).

In this case, applicants have provided a power of attorney stating that the heir is appointing an "administrator" to act on behalf of the heir in matters regarding Japanese patent application No. 321,901/99. Executors are appointed by wills, administrators are appointed by courts, and the heir does not have the power to appoint either. The declaration of inventorship must be signed by the legal representative of the deceased inventor. It may not be signed by another appointed as agent for the legal representative on behalf of the legal representative. See MPEP 605.04(a). In the present case, Akihiko Miyazaki is not the legal representative of the deceased inventor, but rather an agent for the heir. As such, execution of the declaration by Akihiko Miyazaki is improper. If there is neither an executor nor an administrator nor is one required to be appointed by applicable law, then the all the heirs may sign as legal representative. MPEP 409.01(a).

Further, under 37 CFR 1.497(b)(2), the declaration must include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (in addition to the full name and citizenship of the deceased inventor). Even if Miyazaki had been the legal representative of the deceased inventor, the declaration signed by Miyazaki would not have complied with 37 CFR 1.497(b)(2), as it does not list Miyazaki's residence, mailing address or citizenship.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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